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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,978	03/13/2001	Marvin A. Leedom	2506.1009-005	2623

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EXAMINER

NI, SUHAN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,978

Applicant(s)

LEEDOM ET AL.

Examiner

Suhan Ni

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 10-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the election filed 03/29/2004.

Response to the election

2. A provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Other Groups are withdrawn from further consideration by the applicant/examiner, under 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. This application contains claims 10-37 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

4. Applicant's election with traverse of Group I and II in Paper number 13 is acknowledged. The traversal is on the ground(s) that the examiner fails to show the distinction of two groups, which is not found to be persuasive because:

- I. Claims 1-9, drawn to a mechanical securing means of a hearing aid housing, classified in class 381, subclass 321.
- III. Claims 13-14, drawn to the manufacturing of a hearing aid, classified in class 29, subclass 896.21.

The inventions are distinct, each from the other because of the following reason:

Inventions Group III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP ' 806.05(f)). In the instant case, the process can be performed by a different means and/or manufacturing steps.

Because these inventions are distinct for the reasons giving above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I. Restriction for examination purposes as indicated is proper.

Therefore, the restriction requirement is still deemed to be proper and is therefore made FINAL.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it recites the limitation of "the components" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (U. S. Pat. - 5,062,138).

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Regarding claim 1, Schmid discloses a hearing aid, comprising a first half shell (2); a second half shell (3) attached to the first half shell; a plurality of conventional electrical components mounted within a housing formed by shells (Figs. 2-3); securing means (20-21); and a tip (7) attached to the housing as claimed. But Schmid does not clearly teach that the tip is flexible as claimed. Since providing a desirably flexible tip for a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable flexible tip for the hearing aid as an alternate choice, in order to provide users a rather comfortably fitted hearing aid.

Regarding claims 2-3, Schmid further discloses the hearing aid, wherein the securing means is an interlocking joint (17-18, 20-21) as claimed.

Regarding claims 4-5, Schmid does not clearly teach a microphone retainer as claimed. Since providing an acoustic filter for mounting a microphone into a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable acoustic filter, such as a foam cushion for mounting a microphone into a hearing aid housing, in order to reduce some undesirable vibrations.

Regarding claim 6, Schmid does not clearly teach a mushroom shaped tip as claimed. Since providing a mushroom shaped cerumen trapping tip for a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide the mushroom shaped tip for the hearing aid housing, in order to trap cerumen from user's ear canal and make the hearing aid more durable.

Regarding claim 9, Schmid does not clearly teach an adhesive agent as claimed. Since providing a desirable adhesive agent to seal a hearing aid housing members is very well known

in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable adhesive agent for sealing or further sealing the housing members of the hearing aid as an alternate choice, in order to reduce some undesirable vibration and also make the hearing aid more durable.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (U. S. Pat. - 5,062,138) in view of Reiter et al. (U. S. Pat. - 5,606,621).

Regarding claims 7-8, Schmid does not clearly teach a receiver as claimed. Reiter et al. disclose a similar structured hearing aid, comprising an interchangeable tip (18, 22) having a receiver (20). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide the receiver taught by Reiter et al. for the tip of the hearing aid as an alternate choice, in order to deliver an acoustic output to the user more efficiently and effectively.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is (703)-308-9322, and the number for fax machine is (703)-305-9508. The examiner can normally be reached on Monday through Thursday from 9:00 am to 7:30 pm. If it is necessary, the examiner's supervisor, **Curtis Kuntz**, can be reached at (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

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SUHAN NI
PATENT EXAMINER

Suhan Ni
Patent Examiner
Art Unit 2643
USPTO

02/02/2003